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In the Supreme Court of the United States

OCTOBER TERM, 1929

AMERICAN FRUIT GROWERS, INC., PETITIONER

v.

BROGDEX COMPANY

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

MEMORANDUM ON BEHALF OF THE UNITED STATES AMICUS CURIAE

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MEMORANDUM ON BEHALF OF THE UNITED STATES AMICUS CURIAE

The purpose of this memorandum is to bring to the attention of the Court some circumstances which, we submit, give this case a public importance not usual in an ordinary patent suit.

The patent here involved would impose upon dealers in and consumers of a food product of general consumption throughout the nation the duty of inquiry whether the product has been dipped in a solution of borax the effect of which is perceptible only by chemical analysis or microscopic examination. A decision by this Court as to the validity

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of that patent is therefore important in the interest of the public. The growers, packers, and shippers of citrous fruits, and agriculturists generally, have also a vital interest in an early and definite interpretation of the patent here involved, because, in addition to the claims therein which definitely and specifically describe a process, such as claims 5, 7, 14, 15, and 18, the patent includes many claims so indefinite, broad and general as to raise doubts as to what, if any, protective uses of common borax in preparing fruit for market would not be an infringement of the patent. Following recommendations contained in widely distributed bulletins issued by the Department of Agriculture on November 1, 1924, and January 15, 1925, based on its own researches, many fruit growers, packers and shippers have treated citrous fruits with borax solution in reliance upon those official bulletins and without knowledge of the respondent's patent. Some have been sued for infringement, others have been warned to obtain licenses, and the entire industry is in uncertainty as to its rights in the premises. An early decision of this Court upon the question of the validity of the respondent's patent seems essential to clarify the situation and will, it is believed, have the effect of reducing litigation.

The Government itself has a practical and very real interest in the determination of the patentability of the broader claims made in the respondent's patent. How these would affect the useful and important research work of the Department

of Agriculture is set out in a letter of the Acting Secretary of Agriculture to the Attorney General dated March 4, 1930, extracts of which are added hereto as an appendix. Other agencies of scientific research maintained by the Government in the public interest may be confronted with similar difficulties and are therefore equally concerned in having an early decision as to the validity and interpretation of the patent here involved for their guidance.

Respectfully submitted.

WILLIAM D. MITCHELL,
Attorney General.
CHARLES B. RUGG,
Assistant Attorney General.
GEORGE C. BUTTE,
ALEXANDER HOLTZOFF,
Special Assistants to the Attorney General.
J. F. MOTHERSHEAD,
Attorney.

MARCH, 1930.

APPENDIX

(Extracts from letter of the Acting Secretary of Agriculture to the Attorney General, dated Mar. 4, 1930)

* * * * *

Specialists in this Department entertain the view that the decision of the Circuit Court of Appeals in the case referred to has an unusual and important bearing on certain phases of investigative work performed by the Department, and for this reason it also has a bearing on the interests of the agricultural public. As you well know, one of the primary functions of this Department is to inaugurate and carry on varied investigations in the cultivation, production and marketing of agricultural products, with a view to developing new and better methods for their production and handling, and for controlling and eradicating diseases and pests that attack them, and to impart useful information obtained in this way, by bulletins or other means, to the public. In furtherance of this scheme, it is the practice of the Department to prepare and distribute pamphlets and bulletins illustrating and outlining the improvements in methods along such lines which are thought to contain merit in order that the people interested in the discoveries may be enlightened and informed as to their advantages and value. It may be added that nearly all the State agricultural institutions are engaged, more or less, in making similar investigations, and they publish the results they obtain from them in like manner and for the same purpose, either independently or in collaboration with this Department.

There are enclosed several Department circulars dealing with spray materials which indicate the type and character of publications which it prepares and issues in connection with its experimental investigations. The place which these publications have heretofore occupied in the patent field is generally known and understood by agriculturists and Department investigators. Frequently these papers disclose the adaptability of old well-known chemical products to control or eradicate plant pests and diseases. Many agriculturists adopt and follow the processes and methods set forth in these publications, as they feel they may safely do so because the information is brought to them from official sources. While it has been the practice to have our employees developing improved machines or new compounds or new formulae apply for public service patents, thus dedicating their inventions to the use of the Government and the public without requiring the payment of royalties by the users thereof, employees of the Department have not, however, until very recently considered it advisable or necessary, in order to protect interests of the general public, to apply for public service patents upon the adaptation of old machines to new purposes, slight modification of formulae, or the discovery that well-known chemicals had unusual value and specific uses, somewhat widening the general purpose or purposes for which they had formerly been considered.[1]

[1] The record does show (R., Vol. II, Pl.'s Exhs. Nos. 53, 54, 55, 56, 57, 58, 59, pp. 703–717) that employees of the Department of Agriculture obtained patents on processes similar to those in controversy in this case. This may have been done out of abundant caution and does not, we submit, minimize the importance of an authoritative decision on the necessity and validity of such patents.

Heretofore, the Department has felt that it was able to handle the circulation of its bulletins on improved procedures or new uses of well-known materials in a way reasonably to insure protection to agriculturists who might wish to put such processes and methods into actual practice, but it now feels, in the light of the decision rendered by the Third Circuit Court of Appeals in the case above mentioned, that, in many instances, it can not properly safeguard agriculturists against possible litigation if they employ such new processes or methods in their farming activities. In that case, as the facts are understood by the Department, it was shown that citrus fruit and other articles of food had been treated with borax solution for preservation and disinfectant purposes a great many years before Brogden and Trowbridge entered the field. Obviously, when the fruit was immersed in the solution then the borax contained therein had the same effect upon the fruit and accomplished the same results as the use of borax in solution form by the process claimed in the Brogden and Trowbridge patent. It seems, therefore, that Brogden and Trowbridge were not the first to discover the use of borax or boric acid in any specific manner as an antiseptic and preservative, but the opinion cited holds that they discovered that borax was a good inhibiting reagent for controlling blue-mold decay on fresh citrus fruit. A discovery of this nature, according to the viewpoint of Department specialists, is nothing more than the ascertainment of extended use, but of the same general character and not new and original in the sense in which patents are ordinarily granted.

There have been many circulars, and it is contemplated that in the future many more will be issued by the Department, recommending to the public the use of well-known chemicals for various agricultural purposes, but without attempting exhaustively to determine all of the specialized uses for which these substances might prove valuable. If the patent by Brogden and Trowbridge is valid, it would appear to necessitate, on the part of all Federal or other public service institutions carrying forward studies of this general character, the attempt to secure public service patents of the widest character as each new phase of study developed in order to insure free use by the general public of improvements or discoveries reported. Otherwise, it would appear that in almost every phase of agricultural research outside inventors might obtain patents on special phases and through these patents harass and vex farmers with litigation who, relying upon official publications, might be led to infringe such patents. This is a situation which the Department desires to avoid, as it would embarrass not only the farmers but the Department as well. This may be accomplished, it is thought, if the law touching the subject matter of invention as involved in the case of *American Fruit Growers, Inc.*, v. *Brogdex Company*, referred to, is definitely decided.

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